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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,109	11/20/2000	Toshio Sakurai	862.1731 D2	8881
5514	7590	09/07/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			NGUYEN, VAN H	
			ART UNIT	PAPER NUMBER
			2194	
DATE MAILED: 09/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/715,109

Applicant(s)

SAKURAI, TOSHIO

Examiner

VAN H. NGUYEN

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-69 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 30-69 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 30-69 are currently presented in this application.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/786,992, filed on January 13, 1997.

#### ***Claim Objections***

3. Claims 68 and 69 are objected to because of the following informalities:
  - (i) "an din" (claim 68, line 9) should read "and in"
  - (ii) "an d in" (claim 69, line 9) should read "and in"Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 30-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. "the optional unit" (claim 30, line 12; claim 35, line 12; claim 40, line 12; claim 45, line 12; claim 30, line 12; claim 55, line 11; claim 60, line 11; claim 65, line 11) lack antecedent basis.

B. The claim languages in the following claims are indefinite:

- (i) Regarding claim 65, it is unclear if "a device" recited at line 3 is referring to "a device" as recited at line 2.
- (ii) Regarding claim 35, the phrase "a detecting step of detecting whether or not the device" renders the claim indefinite because it is unclear what is to be detected. Is the claim asserting that the existence of the device the issue, or is some operation/state associated with the device the issue to be detected?

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van*

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Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Uogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7. A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

8. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of **U.S. Pat. No. 6,210,051 B1**.

10. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application and claim 1 of patent'051 are both claiming an information processing apparatus which communicates with a device, comprising: detecting the device, obtaining a device ID, discriminating device driver, and warning the device driver. The differences between claim 30 of the instant application and claim 1 of patent'051 would have been obvious to a person of ordinary skill in the art at the time the invention was made, since claim 30 of the instant application represents the invention in broader scope.

11. As to the remaining claims 31-69, they are also rejected under obvious type double patenting as stated in claim 30 above.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 30-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsuoka** (U.S. 5,365,311) in view of **Lipe et al.** (U.S. 5,748,980).

14. The Matsuoka reference was cited in the Applicant's IDS filed 11/20/00.

15. As to claim 65, Matsuoka teaches the invention substantially as claimed including an information processing apparatus (the system) which is connectable to a device (laser printer 1) via a cable (see fig.1 and the accompanying text beginning at col. 4, line 7), comprising:

a detecting (detecting) unit adapted to detect a device (see the detecting device discussion beginning at col.1, line 67; col.17, line 11; and col.18, line 46); and

an obtaining unit adapted to obtain a device ID (device are assigned ID) which the device determines to transmit to the information processing apparatus, on the basis of a type of an optional unit (optional devices) which is attached to the device (see the device ID discussion

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beginning at col.4, line 49 and col.15, line 49), wherein and the device ID is determined depending on a connection status (connection status) of the optional unit to the device (see the connection status and device ID discussions beginning at col.15, line 7 and figs. 12-13).

Matsuoka does teach each of the optional devices comprise a driver (col.4, lines 38-39) and determining whether or not the optional devices can be operated (col.17, lines 61-65).

Matsuoka, however, does not specifically teach a discriminating unit adapted to discriminate whether or not a device driver corresponding to the obtained device ID exists in the information apparatus.

Lipe teaches a discriminating unit adapted to discriminate whether or not a device driver corresponding to the obtained device ID exists in the information apparatus (see the Abstract; col.4, lines 60-66; col.16, lines 49-55; and col.17, lines 28-41).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lipe with Matsuoka because Lipe's teachings would have provided the capability for preventing any conflicting use of the resources by the devices.

16. As to claim 66, Lipe teaches a warning unit adapted to warn when said discriminating unit discriminates that the device driver corresponding to the device does not exist in the information processing apparatus (col.10, lines 4-8).

17. As to claim 67, Lipe teaches a selecting unit adapted to select a device driver corresponding to the device obtained by the obtaining unit, to activate the device driver when the discriminating means discriminates that the device driver corresponding to the device exists in

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the information apparatus (see the device driver identification discussion beginning at col.5, line 25).

18. As to claim 68, the rejection of claim 65 above is incorporated herein in full.

Additionally, Matsuoka further teaches the device driver and the device ID are one-to-one association (col.4, lines 38-51).

19. As to claim 69, the rejection of claim 65 above is incorporated herein in full.

Additionally, Matsuoka further teaches the device driver and the device ID are one-to-one association (col.4, lines 38-51).

20. As to claim 30, the rejection of claim 65 above is incorporated herein in full.

Additionally, Lipe teaches a warning unit adapted to warn when the discriminating unit discriminates that the device driver corresponding, to the obtained device ID is not installed in the information processing apparatus (indication of the absence of...driver; col.10, lines 4-11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lipe and Matsuoka because Lipe's teaching would have provided the capability for detecting the existence of a driver and notifying the absence of the driver to the user.

21. As to claim 31, Matsuoka teaches an activating unit, adapted to activate the device driver to be used (col.15, lines 49-67). Note the discussion in claim 30 above for "when the discriminating unit discriminates that the device driver corresponding to the obtained device ID is not installed."

22. As to claim 32, Matsuoka teaches the device is a printer (a laser printer; see the Abstract).

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23. As to claim 33, Lipe teaches a determination unit adapted to determine whether or not device drivers, which are activated in the information processing apparatus at present (col.10, lines 4-11), are able to support a device driver corresponding to the device on the basis of determining result of the obtained device ID (col.5, lines 25-36; col.16, lines 49-55; and col.17, lines 28-40).

24. As to claim 34, Matsuoka teaches the determination unit determines that the device driver corresponding to the obtained device ID is not supported by the activated device drivers, the discriminating unit performs the discriminating (see fig.4B and the associated text).

25. As to claims 35-39, note the rejection of claims 30-34 above. Claims 35-39 are the same as claims 30-34, except claims 35-39 are method claims and claims 30-34 are apparatus claims.

26. As to claims 40-44, note the rejection of claims 30-34 above. Claims 40-44 are the same as claims 30-34, except claims 40-44 are computer-readable storage medium claims and claims 30-34 are apparatus claims.

27. As to claims 45-49, note the rejection of claims 30-34 above. Claims 45-49 are the same as claims 30-34, except claims 45-49 are computer program product claims and claims 30-34 are apparatus claims.

28. As to claim 50, the rejection of claim 65 above is incorporated herein in full.

Additionally, Lipe teaches installing a device driver corresponding to the device ID obtained by the obtaining means, when it is determined by the first determination means that the connected device can not be supported (a device driver...identified and loaded; see the Abstract and col.9, line 20-col.10, line 3).

It would have been obvious to a person of ordinary skill in the art at the time the

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invention was made to combine the teachings of Lipe and Matsuoka because Lipe's teaching would have provided the capability for identifying a device driver and loading the driver to operate the device.

29. As to claim 51, Matsuoka teaches second determination means for determining whether or not there exists data to be printed in the information processing apparatus, when it is determined by the first determination means that the connected device can be supported and performing means for performing a printing operation on the data when it is determined by the second determination means that there exists data to be printed in the apparatus (col.3, lines 18-20 and col.15, lines 49-65).

30. As to claim 52, Lipe teaches third determination means for determining; whether or not a device driver corresponding to the obtained device ID is installed when it is determined by the first determination means that the connected device can not be supported, wherein the installing means installs the device driver corresponding to the obtained device ID when it is determined by the third determination means that the device driver corresponding to the obtained device ID is installed (see the Abstract and col.9, line 20-col.10, line 3).

31. As to claim 53, Lipe teaches warning means for warning, when it is determined by the third determination means that the driver corresponding to the obtained device ID is not installed (col.10, lines 4-11).

32. As to claim 54, Matsuoka teaches the device comprises a printer (a laser printer; see the Abstract).

33. As to claims 55-59, note the rejection of claims 50-54 above. Claims 55-59 are the same as claims 50-54, except claims 55-59 are method claims and claims 50-54 are apparatus claims.

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34. As to claims 60-64, note the rejection of claims 50-54 above. Claims 60-64 are the same as claims 50-54, except claims 60-64 are processing program claims and claims 50-54 are apparatus claims.

***Response to Arguments***

35. Applicant's arguments with respect to claims 30-69 have been fully considered, but are deemed to be moot in view of the new grounds of rejection.

***Conclusion***

36. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756.

39. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

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